

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/649,293	08/28/00	COHEN	L 2447-012

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EXAMINER

EVANISKO, G

ART UNIT

PAPER NUMBER

3762

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DATE MAILED: 09/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)
	09/649,293	COHEN, LAWRENCE T.
	Examiner	Art Unit
	George R Evanisko	3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 03 August 2001.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-12 is/are pending in the application.

 4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-10 and 12 is/are rejected.

7) Claim(s) 11 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

 a) All b) Some * c) None of:

 1. Certified copies of the priority documents have been received.

 2. Certified copies of the priority documents have been received in Application No. _____.

 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

 a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6, 10 and 12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hochmair et al (4284856).

Claims 1-10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Hochmair-Desoyer et al (“An eight Channel Scala Tympani Electrode for Auditory Prostheses”).

On page 46, the fourth full paragraph, Hochmair-Desoyer describes the spacing between contacts belonging to the same channel as 1.5 mm and between two neighboring contacts of different channels as 0.5 mm. Since the claim is a “comprising” claim (an opened ended claim) and since the claims do not specify which electrodes are being limited, but just use the broad term “electrodes”, Hochmair-Desoyer meets the claim limitations since there will be different channel electrodes at the apical end 0.5 mm apart and same channel electrodes 1.5 mm apart at the basal end. In addition, the use of three consecutive electrodes (different channel and then same channel) will provide the claimed uniformly graduated electrodes. Finally, for claim 5, Hochmair-Desoyer states on page 45, that the contacts are placed as near to excitable nerve-structures as possible.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hochmair et al (4284865).

Hochmair discloses the claimed invention except for the exact spacing between adjacent electrodes at the apical end to be less than the spacing at the basal end, the spacing to be different in different regions, and the spacing to be uniformly graduated between consecutive electrodes. Hochmair does disclose the schematic of the cochlea showing the frequency response, the use of at least four different frequency ranges, the stimulating of the lower frequency stimulation sites near the apex, and does disclose that the electrode contacts can be positioned on the device to stimulate a region of the cochlea for a desired frequency response and in accordance with the frequency response of the cochlea. This provides a clear suggestion that the spacing of the electrodes can be modified to change the distance between adjacent electrodes to have the spacing between adjacent electrodes at the apical end to be less than the spacing at the basal end, the spacing to be different in different regions, and the spacing to be uniformly graduated between consecutive electrodes to correspond to the a desired frequency response and in accordance with the frequency response of the cochlea. The determination of the most appropriate spacing of the electrodes to have a desired frequency response by routine

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experimentation would, therefore, be *prima facie* obvious to one having ordinary skill in the medical art.

Allowable Subject Matter

Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R Evanisko whose telephone number is 703 308-2612. The examiner can normally be reached on M-F 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 703 308-5181. The fax phone numbers for the organization where this application or proceeding is assigned are 703 306-4520 for regular communications and 703 306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1148.

GRE
September 20, 2001

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GEORGE R EVANISKO
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9/20/11